

## REMARKS

Claims 1-9 are pending in the present application and stand rejected. Claims 1-9 have been amended. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the amendments and remarks contained herein.

### REJECTION UNDER 35 U.S.C. § 103

Claims 1-9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Davis (U.S. Pat. No. 5,142,473). This rejection is respectfully traversed.

Claims 1-9 have been amended to clarify that the communications between the microprocessor and the alarm, the ignition disabling switch, or the tilt circuit are via radio frequency signals, infrared signals, or are superimposed over existing wiring of a power boat. In addition, Claims 1-9 require that when an operator **attempts to start** the ignition system when the outboard motor is tilted up beyond a maximum safe tilt position, the alarm is activated by the microprocessor to warn the operator, the ignition disabling switch being activated by the microprocessor **to prevent the operator from starting the ignition system**, or the tilt circuit being activated by the microprocessor to automatically lower the outboard motor.

Davis cannot make Claims 1-9 obvious. First, Davis makes no mention of the use of radio frequency signals or infrared signals to activate an alarm to warn the operator, to activate a disabling circuit to prevent the operator from starting the ignition system, or to activate a tilt circuit to automatically lower the outboard motor. Second, Davis's disclosure does not teach or disclose a system that warns or **prevents an operator from starting the outboard engine** when it is titled beyond a maximum safe tilt position whatsoever. Rather, Davis teaches a system to achieve a more optimal trim

position **while the boat is underway for a smoother boat ride**. For example, Davis does not recognize the problem of depriving the water pump of lubrication prior to ignition, Davis only addresses the performance of the boat after ignition and after the boat is underway. (See specification at paragraph [0027] for further detail on the problems being solved by the claimed invention). The claimed invention and the Davis patent are solving completely different problems, and without a teaching or suggestion to use the microprocessor of Davis as in the claimed invention, Claims 1-9 cannot be obvious.

The Outstanding Office Action states that the last paragraph of each of Claims 1-9 sets forth a function of the apparatus claimed, which cannot be used to distinguish an apparatus from the prior art. The Outstanding Office Action further states that since Davis discloses all of the claimed structure of each apparatus Claims 1-9, the last paragraph of each of Claims 1-9 does not differentiate the claimed apparatus from a prior art apparatus if the prior art apparatus teaches all the structural limitations of the claims.

However, there are precedents holding that "there is nothing inherently wrong in defining something by what it does rather than what it is. See ROBERT C. FABER, LANDIS ON MECHANICS OF PATENT CLAIM DRAFTING § 31, III-48 (4<sup>th</sup> ed. 2002) (citing In re Echerd, 176 U.S.P.Q. (BNA) 321, (C.C.P.A. 1973); In re Hallman, 1210 U.S.P.Q. (BNA) 609, 611 (C.C.P.A. 1981); In re Ludke and Sloan, 169 U.S.P.Q. (BNA) 563 (C.C.P.A. 1971); In re Swinehart and Sfiligoj, 169 U.S.P.Q. (BNA) 226 (C.C.P.A. 1971); In re Fuetterer, 138 U.S.P.Q. (BNA) 217 (C.C.P.A. 1963)). The Court of Appeals for the Federal Circuit also held that no limitation or wording anywhere in the claim can be ignored in determining

patentability. *Id.* (citing In re Stencel, 828 F.2d 751 (Fed. Cir. 1987)). Therefore, the last paragraph of each of Claims 1-9 cannot be completely ignored merely because it “appears” to be functional language.

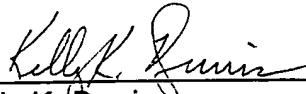
The last paragraph of each of Claims 1-9 is **does** differentiate the claimed apparatus from Davis. The claims recite an interaction between the microprocessor and an alarm, an ignition disabling switch, or a tilt circuit, when an operator attempts to start the ignition system when the outboard motor is tilted up beyond a maximum safe tilt position, which is clearly different than the teaching of Davis. As such, the last paragraph of each of Claims 1-9 imparts a limitation and differentiates each claim from Davis, which does not address the problem solved by the claimed invention, let alone possess a similar circuit or means of communications. Accordingly, Applicant respectfully requests that these claim rejections be withdrawn.

#### **CONCLUSION**

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (314) 726-7524.

Respectfully submitted,

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